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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,493	01/14/2002	John D. Polk	06556.0039	9208
22852	7590	10/31/2007		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER CHEUNG, MARY DA ZHI WANG	
			ART UNIT 3694	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/043,493	<b>Applicant(s)</b> POLK ET AL.	
	<b>Examiner</b> Mary Cheung	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 201-234, 267 and 268 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 201-234, 267 and 268 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to the amendment filed on August 14, 2007. Claims 201-234 and 267-268 are pending. Claims 1-200 and 235-266 are canceled. Claims 267-268 are added. Claims 201, 217 and 233-234 are amended.

### ***Response to Arguments***

2. Applicant's arguments filed July 3, 2007 have been fully considered but they are not persuasive.

In response to the applicant's argues that Kahn fails to teach each batch file including intermediary-requested data, respectfully disagrees. In the applicant's remark section, it is pointed out by the applicant that this limitation is discussed in ¶ 0189 of the specification. Examiner attempted to contact attorney Erika Arner on October 24, 2007 for discussion regarding ¶ 0189 in relation with the intermediary-requested data; however, no return response has been received since. In specification ¶ 0189, it discussed about information delivery method, such as electronic transfers or paper delivery method. Examiner believes that Kahn teaches delivery proper format of the report, such as in electronic format (column 19 lines 43-67) that corresponds to the claimed limitation.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Embrey (US 6,311,170 B1) discussed numerous advantages for using the claimed invention (see column 3 line 56 – column 5 line 34).

Since Applicant(s) did not seasonably traverse the Official Notice statement(s) as stated in the previous Office Action mailed on April 4, 2007, the Official Notice statement(s) are taken to be admitted prior art. See MPEP §2144.03.

### ***Claim Objections***

3. Claims 268 and 269 are objected to because of the following informalities: both claims should depend on claim 201 instead of claim 1 since claim 1 was canceled. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 201, 205-207, 209, 212, 214-217, 221-223, 225, 228, 230-234 and 268 are rejected under 35 U.S.C. 102(e) as being anticipated by Kahn et al., US 6,401,079 B1.

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As to claim 201, Kahn teaches a method for processing payments over a network for a plurality of intermediaries, comprising (abstract and column 11 line 59 – column 12 lines 10 and column 12 lines 45-60 and Fig. 3; *“intermediaries” corresponds to the miscellaneous payees in Kahn’s teaching, such as child support agencies*):

- Receiving employee information from a plurality of employers via network, the employee information corresponding to at least one employee of each employer and including an intermediary identifier (column 5 lines 36 – column 6 line 7 and column 11 line 59 – column 12 line 10 and column 12 lines 45-60);
- Processing at least one employee debit corresponding to the employee information for each employee (column 11 line 59 – column 12 line 10 and column 19 lines 12-32 and Fig. 3);
- processing a credit corresponding to each employee debit (column 19 lines 12-36 and Fig. 3);
- batching the credits into a plurality of batch files based upon the intermediary identifier, each batch file including intermediary-requested data (column 19 lines 12-67 and column 39 lines 10-24 and Fig. 3); and
- sending each batch file, including the intermediary-requested data, to an intermediary based on the intermediary identifier (column 19 lines 12-67 and column 39 lines 10-24 and Fig. 3).

As to claim 205, Kahn teaches delivering each batch file to each intermediary using a communication method matching the intermediary identifier (column 19 lines 12-52 and column 39 lines 10-24).

As to claim 206, Kahn teaches the communication method is electronic funds transfer (column 19 lines 12-52 and column 39 lines 10-24).

As to claim 207, Kahn teaches the communication method is electronic data interchange (column 19 lines 12-52 and column 39 lines 10-24).

As to claim 209, Kahn teaches the network is the Internet (Fig. 1).

As to claim 212, Kahn teaches the network is a wired network (Fig. 1).

As to claim 214, Kahn teaches the employee information relates to a child support payment (column 12 lines 45-60).

As to claim 215, Kahn teaches the debits are processed using debit-based electronic funds transfer (column 19 lines 12-32).

As to claim 216, Kahn teaches the credits are processed using addendum-based electronic data interchange (column 6 line 19-23 and column 19 lines 43-52 and column 51 lines 14-30 and Fig. 3).

As to claim 268, Kahn teaches batching debits from each employer, each batch file representing a debit against the bank account of the employer; storing the information used to create the batched credits and debits, allowing changes to the information by an authorized person; recalculating the batch file when changes are made; resending the debit batch file to the bank of the employer, if necessary; and

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resending the credit batch file to the intermediary, if necessary (column 5 lines 25-35 and column 12 lines 11-44 and column 19 lines 13-67).

Claims 217, 221-223, 225, 228 and 230-234 are parallel with the limitations in claims 201, 205-207, 209, 212 and 214-216; thus, they are rejected on the same basis.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 208, 210-211, 213, 224, 226-227 and 229 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn et al., US 6,401,079 B1 in view of Official Notice.

As to claims 208, 210-211, 213, 224, 226-227 and 229, Kahn does not specifically teach the communication method is paper, the network is an intranet, the network is a wireless network, and the network is a virtual private network. Examiner takes Official Notice for these limitations. It would have been obvious to one of ordinary skill in the art to allow Kahn's teachings to implement these features because by implement these well known in the art features would better meet the users'/employers' needs for attracting more people use Kahn's payroll system.

8. Claims 202-204 and 218-220 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn et al., US 6,401,079 B1 in view of Embrey, US 6,311,170 B1.

As to claims 202-204 and 218-220, Kahn teaches processing the employee debit corresponding to the employee information for each employee , and receiving a credit corresponding to the employee debits as discussed in claim 201 above. Kahn does not specifically teach verifying the employee information using verification information received from an intermediary, processing the employee debit corresponding to the employee information for each employee, when the employee information is verified, and receiving a credit corresponding to the employee debits, when the employee information is verified. However, this matter is taught by Embrey as the trusted financial institution uses the verification information received from the payee to verify the payor information, and process the disbursement between the payor and the payee if the information is positively verified (column 3 lines 49-55 and Fig. 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Kahn's teaching to include the feature of process the disbursement between the payor and payee upon the positively verification by using the verification information received from the payee as taught by Embrey for preventing fraudulent transactions.

9. Claim 267 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn et al., US 6,401,079 B1 in view of Fulton et al., US 6,182,052 B1.

As to claim 267, Kahn teaches batching the debits form each employee, each batch file representing a debit against the bank account of the employee; submitting the debit against the bank account of the employee via a financial clearinghouse based on instructions received from the employer; and receiving a credit for each intermediary corresponding to the debit from the financial clearinghouse, if the debit is applied



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successfully against the bank account of the employer at the employer's bank (column 12 lines 11-44 and column 19 lines 13-42). Kahn does not specifically teach handling a return received from the financial clearinghouse if the debit was not successfully.

However, this matter is taught by Fulton as receiving error message from the clearinghouse if the debit is not successful (column 5 line 63 – column 6 line 2 and column 10 lines 12-17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Kahn's teaching to include the feature of handling a return received from the financial clearinghouse if the debit was not successfully for allowing the unsuccessful debit transaction to be notified.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 201-234 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-48 of U.S. Patent No. 5,946,669.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose disbursement between an employee and a recipient.

12. Claims 201-234 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-70 of U.S. Patent No. 6,119,107.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose disbursement between n an employee and a recipient.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

- (571) 273-8300      (Official Communications; including After Final Communications labeled "BOX AF")
- (571) 273-6705      (Draft Communications)

Mary Cheung  
October 28, 2007



**MARY D. CHEUNG**  
**PRIMARY EXAMINER**